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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,242	11/03/2003	Aaron Caldwell Najera Collins	039928.000006	3781

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EXAMINER

BOCHNA, DAVID

ART UNIT PAPER NUMBER

3679

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/700,242

Applicant(s)

COLLINS, AARON CALDWELL  
NAJERA

Examiner

David E. Bochna

Art Unit

3679



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-17, 19, 28 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8, 18, 20-23, 26 and 29 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 24, 25 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.                                                                        | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 18 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 18 and 29 refer to the height of the retaining lip, however it is unclear how the height is being defined. Is it the height measured from the outlet hole to surface 85, or is it the height or thickness of 43 as measured from the inner surface 29 of the sleeve?

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Blakely '458.

In regard to claim 1, Blakely discloses a tapping sleeve comprising:

first 10 and second 11 sleeve members, the first sleeve member having an outlet aperture 36; and

a gasket 18 having a gasket outlet 39, the gasket outlet having a pair of tapered surfaces 17 on opposing longitudinal sides of the gasket outlet.

Art Unit: 3679

In regard to claim 2, wherein the gasket is a unitary gasket formed by a gasket wall that subtends an arc less than 360 degrees when placed on a pipe in an un-stretched, uncompressed position, thereby forming a gap in the gasket wall.

5. Claims 1-3, 6, 8, 20-23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al. '957

In regard to claim 1, Saito et al. discloses a tapping sleeve comprising:

first and second sleeve members 17, the first sleeve member having an outlet aperture 21;  
and

a gasket 3a having a gasket outlet (space defined by 3a and 3b), the gasket outlet having a pair of tapered surfaces (see fig. 2 where sides of 3b are shown to be tapered) on opposing longitudinal sides of the gasket outlet.

In regard to claim 2, wherein the gasket is a unitary gasket formed by a gasket wall that subtends an arc less than 360 degrees when placed on a pipe in an un-stretched, uncompressed position, thereby forming a gap in the gasket wall.

In regard to claim 6, the first sleeve member is formed from a first sleeve wall having inner and outer surfaces;

the second sleeve member is formed from a second sleeve wall having inner and outer surfaces;

the gasket outlet forms a pair of spaced apart longitudinal surfaces (top surfaces of 3b and a pair of spaced apart lateral surfaces (side surfaces of 3a which face one another) in the gasket, each longitudinal surface being joined at one end to one of the lateral surfaces, and each longitudinal surface being adjacent to one of the tapered surfaces (side surfaces of 3b);

the tapered surfaces are symmetrically disposed about a gasket plane; and  
at a midpoint of the tapping sleeve, each tapered surface forms an angle of about 1 to 20 degrees with the gasket plane (see fig. 2).

In regard to claim 8, further comprising:

an outlet retaining lip (protrusion to the inside of where 19 is pointing) disposed on an inner surface of the first sleeve member surrounding the outlet aperture;

an end retaining lip 24 disposed on the inner surface of the first sleeve member and on an inner surface of the second sleeve member at both ends of the first and second sleeve members;

an annular depression 19 formed by the end retaining lips, the outlet retaining lip, and the inner surfaces of the first and second sleeve members; and

wherein the gasket is capable of being positioned within the annular depression.

In regard to claim 20 Saito et al. discloses a tapping sleeve comprising;

first and second sleeve members 17 having inner and outer surfaces, the first sleeve member having an outlet aperture 21;

an outlet retaining lip (protrusion to the inside of where 19 is pointing) disposed around the outlet aperture;

an end retaining lip 24 disposed on the inner surfaces of the first and second sleeve members at both ends of the first and second sleeve members;

a substantially continuous annular depression 19 formed by the end retaining lips, the outlet retaining lip, and the inner surfaces of the first and second sleeve members;

a unitary gasket 3a having a gasket wall, an inside surface, an outside surface, and a gasket outlet; and

Art Unit: 3679

wherein the unitary gasket is positionable within the annular depression.

In regard to claim 21, wherein the gasket wall subtends an arc less than 360 degrees when placed on a pipe in an un-stretched, uncompressed position, thereby forming a gap in the gasket wall.

In regard to claim 22, wherein:

the gasket wall includes a central portion 3b and a stepped portion 3a; and

the central portion of the gasket is positionable within the annular depression 19 and

the stepped portion 3a is positionable adjacent a radially inward surface 18 of the end retaining lip 24.

In regard to claim 23, wherein:

the gasket is placeable around a pipe such that the inside surface of the gasket is adjacent the pipe and the gasket outlet is aligned with an area of the pipe to be tapped; and the first and second sleeve members are placeable around the gasket and the pipe such that the inner surfaces of the first and second sleeve members are adjacent the outside surface of the gasket.

In regard to claim 26, wherein;

the gasket outlet forms a pair of spaced apart longitudinal surfaces and a pair of spaced apart lateral surfaces in the gasket wall, each longitudinal surface being joined at one end to one of the lateral surfaces, and each longitudinal surface being adjacent to one of a pair of tapered surfaces;

the tapered surfaces are symmetrically disposed about a gasket plane; and at a midpoint of the tapping sleeve, each tapered surface forms an angle of about 1 to 20 degrees with the gasket plane (see fig. 2).

*Allowable Subject Matter*

6. Claims 9-17, 19, 28 and 30 allowed.

7. Claims 4, 7 24-25 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 18 and 29 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. St. Clair et al., Zoldak, and Van Winkle all disclose similar couplings common in the art.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

Art Unit: 3679

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

A handwritten signature in black ink, appearing to read "David Bochna". The signature is fluid and cursive, with a long horizontal stroke at the end.

**David Bochna**  
**Primary Examiner**  
**Art Unit 3679**  
**September 16, 2004**